



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,292	08/08/2001	James J. Cawley	PC10888AJAK	3108

7590

10/08/2002

Gregg C. Benson
Pfizer Inc.
Patent Department, MS 4159
Eastern Point Road
Groton, CT 06340

EXAMINER

SRIVASTAVA, KAILASH C

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 10/08/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/924,292	Applicant(s) CAWLEY ET AL.	
	Examiner DR. Kailash C. Srivastava	Art Unit 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/08/2001 (Paper Number 1).
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-24 are pending.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I – Claims 1-3 and 19 drawn to a process for microbial biotransformation of an hetero atom containing compound to its carboxylic acid, classified under Class 435, Subclass 117, for example.

Group II – Claims 4-8 and 20 drawn to another process for microbial biotransformation of a nitrogen containing aromatic compound to its carboxylic acid, classified under Class 435, Subclass 121, for example.

Group III – Claims 9-11 and 21 drawn to a third process for microbial biotransformation of an hetero atom containing aromatic compound comprising a six member and a five member ring to its carboxylic acid, classified under Class 435, Subclass 126, for example.

Group IV – Claims 12-14 and 22 drawn to a fourth process for microbial biotransformation of a nitrogen containing aromatic compound to its carboxylic acid, classified under Class 435, Subclass 132 or 136, for example.

Group V - Claims 15-16 and 23 drawn to a fifth process for microbial biotransformation of an hetero atom containing aromatic compound to its carboxylic acid wherein the said aromatic compound comprises two six member rings, classified under Class 435, Subclass 41, for example.

Group VI - Claims 17-18 and 24 drawn to a sixth process for microbial biotransformation of an hetero atom containing compound to its carboxylic acid wherein the hetero atom containing compound comprises two six member rings and the hetero atom is on a different ring than the methyl group, classified under Class 435, Subclass 122, for example.

3. Inventions in Groups 1-VI are unrelated to each other because they are directed to inventions that are not connected in design, operation and/or effect. These inventions are independent since they are not disclosed as capable of use together. The inventions have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various inventions at the same time to practice just one invention alone (MPEP § 806.04, MPEP § 808.01). In the instant case, invention disclosed in claims encompassing invention in Group I is directed to a microbial conversion of a substrate that has a different composition and structure to the substrates in anyone of the inventions in Groups II-VI and does not require composition of invention of Group II for example.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each one of the above inventions is not coextensive particularly with regard to the literature search. Further, a reference that would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.


Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification (class/subclass) and their recognized diverse subject matter, restriction for examination purposes as indicated is proper.

4. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b). Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Kailash C. Srivastava whose telephone number is (703) 605-1196. The examiner can normally be reached on Monday to Thursday from 7:30 AM to 6:00 P.M (Eastern Daylight Saving, or Standard time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


Kailash C. Srivastava, Ph.D.
Patent Examiner
Art Unit 1651

October 3, 2002



CHRISTOPHER R. TATE
PRIMARY EXAMINER